

REMARKS

This Amendment responds to the Office Action dated January 11, 2006.

The Examiner rejected claims 1-59 under 35 U.S.C. § 101, arguing that the claims, being directed to a digital file, were directed to non-statutory subject matter. The applicant believes the Examiner's argument to be misplaced, equating a "digital file" with the more abstract term "data structure." This contention is erroneous; though digital files do include data arranged in a known structure, so as to be readable by a computer, a digital *file* is a tangible thing that has data structures in it. The Examiner's citation to *Warmerdam*, 33 F.3d at 360, 31 USPQ2d at 1759 is also misplaced, as the claims at issue in that case were literally directed to a method for generating a data structure, having steps that recited purely mathematical processes. Thus, even when evaluating a product by process claim (i.e. a "data structure" produced by the steps recited in the method claims) the court could conclude that the product by process claim recited only an abstraction, not tangibly embodied in anything. Obviously, the presently claimed "digital file" is something tangible. Unlike the "data structure" of *Wammerdam*, digital files are copied, sold, transferred from one location to another, and are capable of being protected by intellectual property laws such as copyright laws. In other words, the fact that a digital file *may include* data structures, and may therefore be claimed in a manner that distinguishes over the prior art by specifying novel data structures not found in existing digital files, the digital files themselves are not just *data* structures.

Nonetheless, to advance the application to issue, the applicant has amended each of independent claims 1, 15, 29, 41, and 47 to claim a "digital file stored on a computer-readable

medium.” This amendment overcomes the Examiner’s rejection under 35 U.S.C. § 101, and the applicant therefore respectfully requests that the rejection be withdrawn.

The Examiner objected to claims 29 and 42-46 for specified informalities that have been corrected by the present amendment. The applicant therefore respectfully requests that these objections be withdrawn.

The Examiner rejected claims 41-42 and 46 under 35 U.S.C. § 102(b) as being anticipated by Pereira. Independent claim 41 includes the limitations of an “MPEG-7 description scheme” where the MPEG-7 *description scheme* also includes “data for rendering said at least one of said audio and visual media when read by a computer.” The Examiner asserts that Pereira discloses this limitation because that reference discloses an MPEG-7 description scheme and indicates that it may be “co-located” with reproduction data in MPEG-2 or MPEG-4 formats. Pereira, however, makes clear that the term “co-located” *does not* mean that the reproduction data is contained *within* the MPEG-7 description scheme; rather, Pereira merely states that the MPEG-7 data, in an MPEG-7 format, may be stored on the same hard drive, or transmitted in the same data stream, as the MPEG-2 or MPEG-4 reproduction data to which the MPEG-7 description data pertains. The fact that Pereira discloses (1) ordering identification data in an MPEG-7 format; (2) ordering reproduction data in an MPEG-2 or MPEG-4 format; and (3) co-locating MPEG-7 data with associated MPEG-2 or MPEG-4 data on the same hard drive or transmitting them together along the same wire *does not* disclose taking the reproduction data that would ordinarily be contained in an MPEG-2 or MPEG-4 format and including it within the MPEG-7 description scheme. Because the Examiner’s rejection is based on an improper reading

of the disclosure of Pereira, the applicant respectfully requests that the rejection of claims 41, 42 and 46 be withdrawn.

The Examiner rejected claims 47-49 under 35 U.S.C. § 102(a) as being anticipated by IT-JPEG 2000. The applicant's prior response argued that the cited reference, though disclosing UUID boxes, did not disclose the recited limitation that the UUID box include "information . . . indicating the location of binary data, within said file and not within said . . . UUID box." The Examiner found this reasoning unpersuasive, stating that "the features upon which applicant relies (i.e. 'the UUID box disclosed by the IT-JPEG 2000 reference contains no information as to the location of data outside the UUID box' [quoting applicant's prior response]) are not recited in the rejected claims." The Examiner is clearly wrong in this assertion. This feature, upon which the applicant contends distinguishes the presented claims over the cited reference, is recited in independent claim 47 limitation (c) and quoted in the second sentence of this paragraph. To the extent that the Examiner is attempting to read the claim element "UUID Box" so broadly as to read on the UUID Info boxes disclosed in the cited reference, the Examiner's reading is improper. Case law indicates that the Examiner *must* accord each limitation *some* meaning. In other words, the term "UUID" *must be read as a limitation*, and the only means for interpreting the meaning of "UUID" is to refer to either the specification or the prior art to see whether that term has a clearly identified meaning to one of ordinary skill in the relevant art. In this case, the specification indicates that the acronym UUID box does have a particular meaning – a Universal Unique Identifier box that is defined in the JPEG 2000 specification. Thus, when the cited prior art reference *is* the JPEG 2000 specification, which describes both UUID boxes and *associated* UUID Info boxes (that have formats different from a UUID Box) simply containing *references to*


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UUID boxes, then it is illogical to read the term "UUID box" on a UUID Info box. Accordingly, the Examiner's rejection of claims 47-49 is improper and the applicant respectfully requests that the rejection of these claims be withdrawn.

The Examiner rejected claims 1-40, 50-53, and 55-59 under 35 U.S.C. § 103(a) in view of the combination of IT-JPEG 2000 and Qian et al., U.S. Patent No. 6,070,167. Attached to this response is a declaration that establishes an invention date prior to Qian et al., thereby removing that reference under 35 U.S.C. § 102(a) and § 103(a). Therefore, the applicant respectfully requests that the Examiner withdraw the rejection of these claims.

In view of the foregoing amendments and remarks, the applicant respectfully requests reconsideration and allowance of claims 1-59.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Kurt", followed by a series of stylized, wavy horizontal strokes.

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